



Box Non-Fee Amendment  
Attorney Docket No. P15130

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

M. TSILEVICH

Serial No.: 09/544,142

Group Art Unit 1714

Filed: April 6, 2000

Examiner: J. Anthony

For: **ENDOTHERMIC HEAT SHIELD COMPOSITION AND A METHOD  
FOR THE PREPARATION THEREOF**

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This is in response to the Official Action dated January 21, 2003. The one month shortened statutory period for response is set to expire on February 21, 2003; accordingly, this response should be considered timely filed.

SUMMARY OF RESTRICTION REQUIREMENT

Invention Groups. The Examiner has required restriction of claims 1-25 to a single disclosed species under 35 U.S.C. 121.

As the basis for this restriction requirement, the Official Action states the following:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to an endothermic heat shield composition, classified in class 252, subclass 606.
- II. Claims 13-25, drawn to a method for preparing an

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endothermic hat shield composition, classified in class 252, subclass 601.

2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by admixing a small amount of a binder material with the hydrate salt particles to fuse the particles together and than to admix said fused particles with a filler material.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to a plurality of distinct species of th claimed invention in regards to the **filler material**.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of the **filler material** to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the

inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

#### **PROVISIONAL ELECTION**

Applicants provisionally elect the species of Invention II with traverse. Further, Applicants provisionally elect the species of the filler material being a mixture of organic and inorganic components, with traverse. The organic component of the filler material provisionally elected is wood and its by-products, while the inorganic component provisionally elected is glass fibers. Claims 13-19, 21-22 and 24 are readable on the elected species. Applicants respectfully submit that claims 13-16 are generic to all species, and thus, if found allowable, claims drawn to the non-elected species incorporating the limitations of the generic claims would also be available for prosecution at this time.

#### **TRAVERSAL**

Applicants respectfully traverse the Examiner's restriction requirement.

Applicants respectfully disagree with the Examiner's assertion that the present product as claimed may be made by admixing a small amount of binder material with the hydrate salt particles to fuse them together. As is indicated in claim 1 and claim 13, the salt

particles of the presently claimed product and process **are fused together by heating the hydrated salt to a least a temperature at which the salt is in liquid form and the subsequent cooling thereof.** Further, Applicant explicitly states throughout the application that an object of the present inventive subject matter is an improved method and product which **overcomes the disadvantages of the prior art which necessitates the utilization of binder materials** (see for example, the discussion of the prior art indicating the use in the prior art of the binder materials, as well as the objects of the present inventive subject matter as discussed on pages 4-5). Thus, Applicant has specifically shown in the application that the present product **cannot** be made in the alternate manner suggested by the Examiner, i.e., by admixing a small amount of binder with the hydrate salt particles to fuse the particles together.

Since the presently claimed product cannot be made in the alternative manner suggested by the Examiner, Applicant respectfully submits that restriction to either one of the two invention groups **is improper.** As such, Applicant respectfully request reconsideration and withdrawal of the restriction requirement.

Further, the restriction requirement is traversed because it

omits "an appropriate explanation" as to the existence of a "serious burden" if a restriction were not required. See MPEP 803. Regardless of any differences which may exist between the inventions set forth in the different species, a complete and thorough search for the invention set forth in any one of the species would require searching the art areas appropriate to the other species. All of the species are directed to a filler materials **and the number of filler materials listed is not so great as to be an onerous burden on the Examiner** to search them all. Since a search of each of the inventions of the species would be coextensive, it would not be a serious burden upon the Examiner to examine all of the claims in this application.

Further at the Examiner's disposal are powerful electronic search engines providing the Examiner with the ability to quickly and easily search all of the claims. Considering that the Examiner will most likely undertake a search for the power plant of claim 1, searching for the power plant of other independent claims would be minimally burdensome on the Examiner.

Moreover, given the overlapping subject matter and nearly identical classifications of the species, examinations of all the invention groups would not pose a serious burden because they would be coextensive. Further, the fact that various claims may fall

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under different U.S. Patent and Trademark Office classes does not necessarily make them independent or distinct inventions. The classification system at the U.S. Patent and Trademark Office is based in part upon administrative concerns and is not necessarily indicative of separate inventive subject matter in all cases.

Furthermore, Applicant has paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring applicants to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing Applicant to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional applications) are not refundable.

In view of the foregoing, Applicant respectfully request the Examiner to reconsider and withdraw the restriction requirement, and to examine all of the claims pending in this application.

If the Examiner has any questions or comments regarding this matter, he is welcomed to contact the undersigned attorney at the below-listed number and address.

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Respectfully submitted,

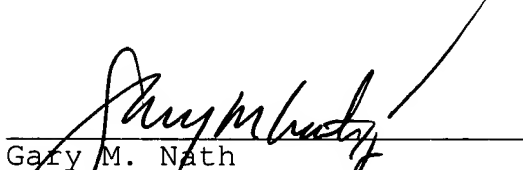
**NATH & ASSOCIATES**

Date:

February 21, 2003

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